

No. 14800

---

In the  
United States Court of Appeals  
For the Ninth Circuit

---

FRANCES P. SYRACUSE and NEW  
WONDER BAG CORPORATION,  
*Appellant.*

vs.

HARRY PARIS, et al.,

*Appellees.*

---

Petition for Rehearing

---

ALAN FRANKLIN  
354 S. Spring Street  
Los Angeles 13, California  
*Attorney for Appellant*

---

FILED

JUL -5 1956

PAUL P. O'BRIEN, CLERK



## TOPICAL INDEX

	Page
And So "The Leopard Has Changed His Spots".....	14
Defendant's (Appellee's) Irrelevant Prior Art.....	16
Affidavits .....	18
Appellees' Lack of Defense.....	27
Conclusion .....	28
Certificate .....	29

---

## TABLE OF CASES AND AUTHORITIES CITED

### Cases

Ace v. Exhibit Supply, 119 F. (2d) 349, mod. 315 U.S. 126, 86 L.ed. 736.....	26
Cold Metal Process Co. v. Carnegie-Illinois Steel, 180 F. (2d) 322, C.C.A. 3 (1939) c.a. 309 U.S. 665, 84 L. Ed. 1012 (1940).....	24
Continental Paper Bag Co. v. Eastern Paper Bag Co., 210 U.S. 405, 416, 422, 28 S. Ct. 748, 52 L.ed. 1122 .....	6
Crowell v. Baker Oil Tool Co., (9th Cir.), 153 F. 2d 972.....	5
Electro Mfg. Co. v. Yellin (C.C.A. 7) 56 U.S.P.Q. 290, 292; 132 F. (2d) 979.....	25
Faulk v. Gibbs, 174 F. 2d 34 (C.C.A. 9).....	5
Griffith v. Utah Power and Light Co., 21 Fed. Rules Serv. 56 d, Case 2; ..... F. (2d) .....	8
Hycon Mfg. Co. v. H. Koch & Sons (C.C.A. 9), 104 U.S. P.Q. 231.....	4

	Page
Kellogg Switchboard & Supply Co. v. Michigan Bell Tel. Co., 99 F. (2d) 207; cert. den. 308 U.S. 582, 84 L. Ed. 488 (1939).....	26
Kendall Co. v. Earnshaw Knitting Co., 3 F.R. Serv. 56 c. 41, Case 4; 1 F.R.D. 357 (D.C.D. Mass., 1940) .....	8, 9
Leeds & Catlin Co. v. Victor Talking Mach. Co., 213 U.S. 301, 302, 311 and 319, 29 S. Ct. 495, 53 L.ed. 805 .....	6
Luck v. Coe, 69 F. (2d) 379, App. D.C. (1934).....	26
McAlester v. United States, 348 U.S. 19.....	8
McRoskey v. Braun, 107 F. (2d) 143, 147 C.C.A. (1939) .....	5
Nichol v. Schick, 98 F. (2d) 511, 513 (1938).....	5
Payne v. Williams-Wallace Co., 117 Fed. (2d) 283 C.C.A. 9 (1941), c.d. 313 U. S. 572, 85 L. Ed. 1530) .....	25
Pointer v. Six Wheel Corp., 177 F. 2d 153 (C.C.A. 9) .....	5
Refractolite Corp. v. Prismo Holding Corp., 1 F.R. Serv. 56 a. 24, Case 1; 25 F. Supp. 965 (D.C.S.D. N.Y., 1938).....	8
Reinharts, Inc., v. Caterpillar Tractor Co., 85 F. (2d) 628, at p. 630, C.C.A. 9 (1936).....	5
Shumacher v. Button Lath Mfg. Co., (C.C.A. 9) 292 F. 522, 533.....	5
Stilz v. U. S., 269 U.S. 144, 147; 70 L.ed. 202.....	6
Stoodly Co. v. Mills Alloys, (C.C.A. 9) 67 F. (2d) 807, 812 .....	5

	Page
Thompson Spot Welder Co. v. Ford Motor Co., 265 U.S. 445, 446, 44 S. Ct. 533, 68 L.ed. 1098.....	5
Topliff v. Topliff et al., 145 U.S. 156, 36 L. Ed. 658	26
Williams v. Carolina Life Insurance Co., 348 U.S. 802 .....	8
Williams Mfg. Co. v. United States Shoe Machinery Corp., 121 F. (2d) 273. Affirmed 316 U.S. 364, 62 S. Ct. 1179.....	26
Williams v. Syracuse Co., 161 Fed. 571 (N.D. N.Y., 1908) .....	23

### Codes, Statutes, Texts, etc.

Federal Rules of Civil Procedure, Rule 56 (b).....	18, 19
Federal Rules of Civil Procedure, Rule 56 (c)..... .....	4, 6, 7, 18
Patent Law and Practice—Amdur 64, sec. 49.....	23
U. S. Code, Title 28, Ch. 115, section 1774..... .....	10, 12, 13, 14, 15, 16
U. S. Code 1953, Title 35, Ch. 29, section 102(b)....	2, 4, 17
U. S. Code 1953 Title 35, Ch. 29, section 282.....	17, 19, 27
Walker on Patents, Deller's Ed., sec. 25, pp. 112, 113	5
Walker on Patents (1955 Cu. Supp.) (Deller's Ed.) Vol. III, p. 1680, section 450.....	6



In the  
United States Court of Appeals  
For the Ninth Circuit

---

FRANCES P. SYRACUSE and NEW  
WONDER BAG CORPORATION,  
*Appellant.*

vs.

HARRY PARIS, et al.,

*Appellees.*

---

No. 14800

**Petition for Rehearing**

---

*To the Honorable, the Judges of the United States  
Court of Appeals for the Ninth Circuit:*

Comes now the appellant and petitions this Honorable Court for a rehearing of this appeal, upon the grounds hereinafter set forth.

At the outset of this petition for a rehearing it behooves the appellants to point out to this Honorable Court a fatal defect in the appellees' (defendants') Amended Answer, filed April 1, 1954, which defect forecloses appellees' astute attorney from foolishly prating about his pet delusion that the invalid Shanzer-Design patent 147,477 is an anticipation of the appellants' novel and highly useful *mechanical utility* patent in suit, No. 2,533,850. The defect in the appellees' (defendants') Amended Answer, which eliminates the

appellees' (defendants') alleged false *defense of invalidity of the patent in suit*, is the failure of defendants' attorney to *plead* said Shanzer Design patent in his Amended Answer, and particularly in Paragraph IV thereof (Tr. pp. 6 and 7).

Patent Laws, January 1, 1953, §282,

“The following shall be defenses in any action involving validity or infringement of a patent and *shall be pleaded.*”

#### §102.(b) Conditions for patentability.

Said Shanzer patent appears for the first time, *not in a pleading*, but in a *self-serving affidavit of defendants' counsel, C. G. Stratton*, sworn to September 3, 1954, over *five months* after said Amended Answer was filed. *No date* is noticed, by defendants' attorney or anyone, for hearing the defendants' motion for summary judgment, and it does not appear in the Transcript of Record when said motion was heard, or that said motion was heard on the *pleadings* and particularly the Amended Answer. If said motion was heard on anything but the pleadings, as it appears, said summary judgment is ineffective, at least in so far as the Shanzer patent is concerned. The affidavit of the defendants' (appellees') attorney (Tr. pp. 12-13), is *not a pleading*, which is required for setting up a *prior patent to invalidate a patent in suit*, which can only be invalidated by properly *pleading* such invalidity and *by proof of the same beyond a reasonable doubt*.



“Ordinarily an affidavit by an attorney is insufficient to support a motion for summary judgment.” *Cornacchio v. Coniglio*, 11 F.R. Sec. 83.611, Case 2; 7 F.R.D. 749 (D.C. E.D. N.Y., 1947).

“An affidavit of counsel in opposition to a motion for summary judgment does not meet the requirements of Rule 56 since the attorney is not a competent *witness*. *Robinson v. Waterman S.S. Co.*, 11 F.R. Serv. 56 c. 41, Case 5; 8 F.D.R. 155 (D.C.D. N.J.)”

The Shanzer patent No. Des. 147,477 is the booby prize of the appellees' defenses in that it *eliminates itself as prior art* for the patent in suit and condemns itself out of its own mouth. The *date* of the Shanzer patent, Sept. 9, 1947, which appears on its face, is not *more than one year prior to the application date Sept. 13, 1947*, of the Syracuse patent in suit No. 2,533,850, and consequently the Shanzer patent, if valid, which it is not, *is not prior art*, and since the Shanzer patent is asserted by appellees' attorney, on page 3 of Appellees' Brief, that “*The closest prior patent is probably Shanzer patent No. Des. 147,477,*” said patent is the dominant exhibit of said attorney's ill-advised motion for summary judgment which subjects said appellees' attorney to a punitive fine by this Honorable Court for filing a frivolous motion.

The fact that the Shanzer patent is not prior art compared to the Syracuse patent in suit and cannot be set up to anticipate the patent in suit is governed by a statute of limitations as follows:

Patent Laws, January 1, 1953, U.S.C., Title 35

“§102. Conditions for patentability; novelty, etc. A person shall be entitled to a patent unless—  
(b) the invention was *patented* or described in a printed publication in this or a foreign country or in public use or on sale in this country, *more than one year prior to the date of the application* for patent in the United States.”

The Shanzer Bag was *not patented* (Sept. 9, 1947) “more than one year prior to the date of the (Syracuse) *application* (Sept. 13, 1947) for patent in the United States.” The Shanzer bag was *patented Sept. 9, 1947, only four (4) days “prior to the date of the application” Sept. 13, 1947* for the Syracuse patent in suit.

The conditions for patentability of the above patent statute §102 (b), which is the law of the land, has reduced the Shanzer patent to a fatal anachronism, and to *innocuous desuetude*, so far as the Syracuse patent in suit is concerned.

A grave injustice has been done to plaintiff-appellants, by the crude and most irregular judgment of the District Court, and the legally-unsupported affirmance of said judgment by this appellate court, in view of Rule 56 (c) of the Federal Rules of Civil Procedure, and the ruling law of this circuit as established by this court in the case of *Hycon Mfg. Co. v. H. Koch & Sons* (C.C.A. 9), 104 U.S. P.Q. 231, and the following cases decided by the Court of Appeals of this circuit, which hold that the question of *invention* is a *question of fact*.

*Crowell v. Baker Oil Tool Co.*, (9th Cir.), 153 F. 2d 972, has held as follows:

“The question whether or not a new and useful combination is the result of mere *mechanical skill or of inventive faculty* is one of fact.”

*Faulk v. Gibbs*, 174 F. 2d 34 (C.C.A. 9);

*Pointer v. Six Wheel Corp.*, 177 F. 2d 153 (C. C.A. 9);

*Stoody Co. v. Mills Alloys*, (C.C.A. 9) 67 F. (2d) 807, 812;

*Shumacher v. Button Lath Mfg. Co.*, (C.C.A. 9) 292 F. 522, 533.

Other cases decided by this Circuit Court of Appeals hold that the question of *infringement* of a patent is also a question of fact.

*Reinharts, Inc. v. Caterpillar Tractor Co.*, 85 F. (2d) 628, at p. 630, C.C.A. 9 (1936);

*McRoskey v. Braun*, 107 F. (2d) 143, 147 C. C.A. (1939);

*Nichol v. Schick*, 98 F. (2d) 511, 513 (1938).

The question of *invention and validity* of a patent has been held by the U. S. Supreme Court to be a question of fact.

*Thompson Spot Welder Co. v. Ford Motor Co.*, 265 U.S. 445, 446, 44 S. Ct. 533, 68 L.ed. 1098.

The leading textbook, Walker on Patents, Deller's Ed., Sec. 25, pages 112 and 113, states:

“That the question of *invention is a question of fact.*”

The question of *infringement* of a *patent* has been adjudicated by the *Supreme Court to be a question of fact*.

*Stilz v. U. S.*, 269 U. S. 144, 147; 70 L.ed. 202.

The leading textbook on patents, Walker on Patents, Deller's Ed., p. 1680, sec. 450, holds:

*"Infringement is a question of fact."*

See *Leeds & Catlin Co. v. Victor Talking Mach. Co.*, 213 U.S. 301, 302, 311 and 319, 29 S. Ct. 495, 53 L.ed. 805;

*Continental Paper Bag Co. v. Eastern Paper Bag Co.*, 210 U.S. 405, 416, 422, 28 S. Ct. 748, 52 L.ed. 1122.

See also 1955 Cumulative Supplement, Walker on Patents (Deller's) Vol. III, page 1680, §450, Infringement defined.

The above authorities cited on Appellants' Motion, after refusal of this Court to hear appellants' appeal, on a false issue raised by attorney for appellee, nullified the summary judgment of the lower court and left this court with no alternative other than to reverse and vacate said summary judgment of the lower court and remand the case to the lower court for trial *de nova* on the merits.

It should be obvious, in view of Rule 56 (c) and the above cited authorities, that no patent infringement suit is dismissable by summary judgment, in view of the major issues of material facts which the questions of *invention* and *infringement* necessarily raised on

such motions in patent litigation. It was hoped that this Court would recognize said basic conclusions of patent law on this appeal of the wild summary judgment of the lower court in this case. However, the decision of this Court in this particular case and *circuit*, "cannot be considered as too much authority for the upholding of summary judgments in patents suits," as this Court states in its opinion at the end of page 3 thereof. Counsel for appellant does not agree with the opinion of this Court that the "trial court was correct in its disposition of the case . . . due to the manner in which the case was presented to the trial court." Rule 56 (c) F. R. C. P. provides:

"The judgment sought shall be rendered forthwith if the *pleadings* . . . show that, except as to the amount of damages, *there is no genuine issue as to any material fact* and that the moving party is entitled to judgment as a matter of law."

In the case at bar the pleadings clearly show that the appellant, Syracuse, has a patent for an invention, which is *prima facie valid*; that said pleadings raise the issue of *validity* of said patent and the issue of *infringement* thereof, which issues are *genuine issues of fact*; and the pleadings present a *prima facie showing of infringement of said letters patent by the defendant*, for which the defendant is liable for damages and an injunction.

In view of the genuine issues of fact raised by the pleadings, the trial judge should have *denied* the defendant's legally defective motion for summary judg-



ment, and it was gross error of the trial judge to grant the defendants' motion for summary judgment and hold the patent in suit invalid and particularly, on defendants' attorney's *single self-serving affidavit only*, when the patent law requires that a patent can be held invalid only by *proof beyond a reasonable doubt*.

"In a patent suit, defendants' motion for summary judgment, based in part on an averment of invalidity for want of invention in view of prior art, was denied." *Kendall Co. v. Earnshaw Knitting Co.*, 3 F.R. Serv. 56 c. 41, Case 4; 1 F.R.D. 357 (D.C. D. Mass., 1940)

"Summary judgment should not be granted in a patent suit in which the issues involve the validity and alleged infringement of unadjudicated patents" *Refractolite Corp. v. Prismo Holding Corp.*, 1 F.R. Serv. 56 a. 24, Case 1; 25 F. Supp. 965 (D.C. S. D. N.Y., 1938).

"Summary judgment may not be granted if any genuine issue of a material fact exists on which there is a right to trial by jury or by the court. All doubts must be resolved against the moving party."

*Griffith v. Utah Power and Light Co.*, 21 Fed.

Rules Serv. 56 d, Case 2; ..... F. (2d) .....

*Williams v. Carolina Life Insurance Co.*, 348 U. S. 802;

*McAlester v. United States*, 348 U. S. 19.

"Summary judgment may not be granted if there are genuine issues of material facts to be resolved."

(*Petition for Rehearing granted*) U. S. Court of Appeals, Fifth Circuit, May 27, 1055, 21 Fed. Rules Serv. 56 c. 41, Case 4; ..... F. (2d)

.....

A false issue was injected into the appeal of this case by the appellees' attorney in a futile effort to divert the attention of this Court from the real issues of this appeal and the merits of this case, but this Court in its recent opinion of this appeal evidently got a glimmer of appellees' attorney's spurious issue, when the lost patent in suit No. 2,533,850 came home to roost, to the Clerk of this Court, at the threshold of this appeal. Evidently appellees' attorney got scared and filed the patent in suit with the Clerk of this Court when he remembered that counsel for appellant had accused him at the hearing of this appeal of having said patent surreptitiously in his possession and that the matter would be presented to and investigated by the State Bar, and when he also remembered the affidavit of the appellant Mrs. Syracuse, swearing that she actually saw the appellees' attorney C. G. Stratton pick up her patent from the reporter's table at the close of the deposition of the defendant Paris by her former attorney, Mr. Geauque. While appellees' attorney denied that he unlawfully misappropriated the appellants' patent at the defendants' deposition, it is rather significant that his denials are *not under oath*, and it is also rather significant that the *patent in suit was kept out of the files of the lower court and out of access of appellants' attorney and this Court, until*

*after the hearing on this appeal, which concealment of said patent from this Court mislead and caused this Court erroneously to refuse to hear oral argument of appellants' counsel because he did not have in his possession the actual patent in suit, which as a matter of law was of no consequence, and it was error on the part of this Court in view of Section 1774, Title 28, Ch. 115, which provides:*

“Copies of letters patent or any records, books, papers, or drawings belonging to the Patent Office and relating to patents, authenticated under the seal of the Patent Office and certified by the Commissioner of Patents, or by another officer of the Patent Office authorized to do so by the Commissioner, shall be admissible in evidence with the same effect as the originals.”

It was appellees' attorney on page 1 of the Appellees' Brief who first raised the *false* issue that the patent in suit was not in the Transcript of Record and stated that if the Court wished to be technical, this appeal could be dismissed upon that ground alone. Evidently said statement misled this Court at the hearing of this appeal, when it refused, contrary to the law (Sec. 1774, Title 28, Ch. 115), to allow counsel for the appellant to proceed with his argument without possession of the actual patent in suit, which at this time was unlawfully in the possession of the appellees' attorney, who had picked up said patent at the end of the deposition of the defendant Paris, and put said patent in his brief bag and walked out of the deposi-



tion room with it, and has retained said patent in his possession until recently, after the hearing of this appeal, when he filed said patent with the defendants' deposition in the office of the Clerk of this Court. Fortunately for the appellants' the appellant, Mrs. Syracuse, *saw* the appellees' attorney pick up her patent and walk out of the deposition room with it for the purpose of suppressing the same — *valuable evidence criminally suppressed by defendants' attorney from appellants' counsel and this Court to obstruct and prevent the administration of justice in this case.*

The appellant, Frances P. Syracuse, in her affidavit attached to Appellants' Motion To Reverse and Vacate Summary Judgment of Lower Court, etc., dated February 6, 1956, avers as follows:

“At the taking of said deposition of said defendant-appellee Harry Paris, my attorney, Robert E. Geauque, introduced in evidence my Letters Patent in suit No. 2,533,850, and I saw it handed to the deposition reporter and notary public who marked my said patent Plaintiffs' Exhibit ‘C’. (See deposition of said defendant Harry Paris, page 23.) When the deposition of said defendant Harry Paris was completed, I saw said C. G. Stratton, attorney for said defendant Harry Paris, pick up my said patent (which was then in evidence) and put my patent in his briefcase and walk out of the deposition room with my patent and I have never seen and neither has my attorney, Robert E. Geauque, who took the defendants' deposition, my patent since.”

The above-quoted affidavit of the appellant, Mrs. Syracuse being under oath, the *unverified* denials, and the false statement by appellees' attorney to this Court at the supposed hearing of this appeal, that "*the patent was before the lower court,*" only emphasize the truth of Mrs. Syracuse's affidavit, and condemn said dishonorable attorney out of his own mouth.

Counsel for appellants heard the appellees' attorney in court tell this Court that the original patent in suit was before the lower court, but it is significant that there was never any record of said patent being before the lower court and the trial judge, while he remembered the details of the case could not actually remember ever seeing said patent, but believed there was a certified copy of the patent in evidence before the court, which was counter designated by the appellees' attorney on page 31 of the Transcript of Record, as "File Wrapper and contents of the patent in suit." The trial judge was obviously correct, because the patent was at the outset delivered by the appellant, Syracuse, to her first attorney, Robert E. Geauque, who introduced said patent in evidence while taking the deposition of the defendant, Harry Paris, where the appellees' attorney C. G. Stratton *stole* said patent and *unlawfully retained* it in his possession until after the hearing of appeal of this case, so that appellants' counsel could not produce it when this Court arbitrarily required him to do so, and refused to hear said counsel's oral argument for that reason, in the face of a Federal statute authorizing the use of copies of said patent, Title 28, Ch. 115, Section 1774. Appel-

lants' attorney is satisfied that the trial judge never saw the original patent in suit, but had only the "File Wrapper and contents of the patent in suit," as counter designated (Tr. p. 31) by appellees' attorney, and that this Court's arbitrary ruling depriving counsel for appellant of the right to argue his case without the original patent in suit stems only from the unmerited self-serving statement of appellees' attorney, in Appellees' Brief, (first page) that "*It will be noticed that the patent in suit is not in the Transcript of Record. If the Court wishes to be technical, this appeal could be dismissed upon that ground alone,*" as if the patent in suit was indispensable to a valid judgment of this Court. Later on when appellees' attorney learned the real law, Title 28, Ch. 115, Sec. 1774, that copies of an original patent could be admitted in evidence in place of the original patent, he adopted said law as his own, in his overdue Appellees' Reply To Appellants' Motion to Reverse, etc., in his following language:

*"The original patent is worthless to counsel or to anyone else, except as a matter of pride to the patentee, etc. . . . For all purposes of this or any other lawsuit, A CERTIFIED COPY would be fully as good as the original."*

## AND SO "THE LEOPARD HAS CHANGED HIS SPOTS"

It is obvious that the patent in suit was *not before the lower court*, because it was at the time surreptitiously in the possession of plaintiffs' (appellees') attorney C. G. Stratton, who had an ax to grind in concealing said patent from said court and the appellant, Mrs. Syracuse, which patent said unethical attorney for defendant (appellee) had stolen from the plaintiff, Mrs. Syracuse, a year before the motion for summary judgment, at the end of the plaintiffs' deposition of the defendant, Paris.

In view of the unethical and shyster practice of the appellees' attorney in stealing the appellants', Mrs. Syracuse's, patent, and, in falsifying the fact to this Court that the patent in suit was before the lower court, when it was not, for the purpose of inducing this Honorable Court dismiss the appellants' appeal, contrary to law, Title 28, Ch. 115, Section 1774, because they could not produce the patent in court when it was in the possession of appellees' attorney, it is the manifest duty of this Honorable Court to disqualify and remove the appellees' attorney, C. G. Stratton, completely from this case. The State Bar is going to disbar said attorney from practice in this State anyway. He is a bad actor, and was some time ago forced to resign from the Los Angeles Patent Law Association for unethical advertising, and for insulting the officers of the L. A. Patent Law Association when he was admonished for engaging in such advertising.

It is noted in this Court's opinion, page 2, that the record needed no supplementing by the offer of appellants' counsel of a certified copy and a government-printed or soft copy of the patent in suit, when the Court already had appellee's certified copy of the File Wrapper and contents of the patent in suit and the record needed no "supplementing." The Court admitted that it had the File Wrapper and contents of the patent in suit, which was the same legal document upon which the lower court rendered its irregular and illegal summary judgment, from which appellants appeal, and consequently the subject matter of the summary judgment and this appeal therefrom are one and the same, to-wit: the patent in suit, which may be evidenced in both the lower and this Court by certified and other copies of said patent as the record of the case presents according to Title 28, Ch. 115, Sec. 1774. The reason counsel for appellant offered to supplement the record at the hearing of this appeal with documents he knew were legal and official, was because he was unable to find the patent in suit or a certified copy thereof in the file of the case in the District Court Clerk's office, from which file important papers had obviously been removed, and counsel for appellant was desirous of having only authentic documents in the Court's possession. Counsel for appellant did not actually know that there were certified copies of official documents of the patent in suit in the Transcript of Record until after the hearing of the appeal, when he actually saw the papers which were on file in the office of the Clerk of this Court. What appellants' counsel could not understand at first



quired said exhibit might be a convenient anchor to the windward for the appellants. We do not agree with the Court's Opinion that plaintiffs apparently "resisted the motion for summary judgment with no affidavits that tendered any issue of fact." The *two* affidavits that established the fact that Plaintiffs' Exhibit X, Brief Case, was given to appellant's counsel over ten years before the analogous Shanzer Utility Bag was patented, raised the factual issue that the Shanzer patent is invalid in view of the prior Plaintiffs' Exhibit X.

## AFFIDAVITS

Affidavits are not indispensable in a motion for summary judgment. In Rule 56(b), F. R. C. P., it is provided: "A party against whom a claim etc. is asserted etc. *may* at any time, move *with or without supporting affidavits* for a summary judgment" etc. Rule 56(c) provides: "The judgment sought shall be rendered forthwith if the pleadings etc., together with the *affidavits, if any*, show etc. there is no genuine issue as to any material fact" etc. It has above been pointed out in numerous authorities that the questions of *validity and infringement* of a patent are genuine material issues of *fact*, which, in this case, defeat the lower court's summary judgment, because those material issues of fact were *raised by the pleadings* in the lower court, and by the Brief Amicus Curiae of Alan Franklin, filed in the lower court with said court's *permission, before* the Summary Judgment of said court was rendered. (See pages 4-5 of said brief).

We do not agree with the Court's Opinion, page 2, that "It does not appear that the defendant's affidavits set up any inconsistencies or contradictions requiring a trial." We find only *one* affidavit, and that one by the defendant's attorney, in the Transcript of Record, which affidavit mentions the Shanzer (Des.) Patent—Sept. 9, 1947, but defendant failed to plead said patent in his Amended Answer, in accordance with §282, Ch. 29, Title 35, Patents, U. S. Code 1953. Said *attorney's affidavit*, moreover, is not admissible under Rule 56 because the *attorney* in a motion for summary judgment cannot be a *witness* for the defendant on such motion.

In the last analysis of the case the summary judgment of the lower court is not supported by a scintilla of evidence, since the affidavit of the defendant's attorney, C. G. Stratton (Tr. pp. 12-13) cannot be accepted as *evidence* by this Honorable Court, and said defendant (appellee) *has no other evidence*. On the other hand appellant's have two affidavits and a photograph of the brief case or handbag, Plaintiffs' Exhibit X, in evidence, and while the court may disregard the affidavit of appellant's attorney, Alan Franklin, the affidavit of J. Calvin Brown (Tr. p. 22), said photograph and the worn actual handbag, Exhibit X, still in appellant's possession, give the appellant's the preponderance of evidence in this case, and they are entitled to a judgment of reversal and dismissal, by this court of the lower court's summary judgment, and the appellants are further entitled to a mandate of this

court ordering the lower court to proceed forthwith on the merits of the case at bar.

The bald contention of the appellee's attorney that the Commissioner of Patents *failed to cite* against the application for the patent in suit *the most pertinent prior art* including the Shanzer Design Patent, No. 147,477, exposes the key to defendant's (appellee's) attorney's pseudo defense, that the able, expert, experienced and highly efficient Patent Office examiners are not quite as capable or more capable than he or other outside unofficial and less experienced patent searchers are to make searches in the Patent Office. The fact that the Shanzer patent was not issued *more than one year* before the application for the patent in suit was filed in the Patent Office, eliminated *prima facie*, at least the Shanzer patent as prior art and a reference against the patentability of the appellant Syracuse's patent in suit. The inapplicability of the Shanzer patent as an anticipation of the patent in suit was overlooked by the appellee's attorney, but was *discovered by the abler examiner* in the Patent Office, and was the valid reason why the Patent examiner did not cite the Shanzer patent against the patent in suit. This is an illustration of the fact that the Commissioner of Patents, not appellee's attorney, cited the most pertinent prior art against the Patent in suit. The lower court's so-called Finding of Fact (8) is, not only a gross error, but is an obvious absurdity. The Commissioner of Patents certainly *did not fail* to cite against the application for the patent in suit the most pertinent prior art, *by not including the irrelevant and self-*



*eliminated Shanzer, Design Patent No. 147,477, which discloses nothing but its external so-called ornamental appearance, no part of which is novel, in view of Plaintiff's Exhibit X, except possibly the bows on the front wall of said design patent, at diagonal corners of said front wall, in Fig. 1 of said patent, which bows are not included in the patent in suit and are no part of the invention of the appellant's said patent. Said Shanzer patent absolutely does not describe or show the combination claimed in the patent in suit, and the last sentence of said Finding of Fact (8) attempting to define the invention of the patent in suit is nothing but an irresponsible unsupported conclusion of law. Finding of Fact (8) was obviously written by the appellee's attorney, because it has all of the sardonic earmarks of the defendant's (appellee's) attorney. The last sentence of said Finding of Fact (8) shows the unmitigated presumption of said attorney in attempting to define invention, which defies definition. Every time the question of defining what constitutes invention has been submitted to the Supreme Court for adjudication that high Court has side-stepped that question.*

The so-called remaining pertinent prior art patents are more remote from the patent in suit, as indicated in Appellee's Brief, than the Shanzer patent which on its face is eliminated as prior art against the patent in suit. All of said remaining unofficial patents set up are too large, clumsy and heavy to be used as nursing bags for babies by mothers carrying their babies. There is no suggestion in any of said remote patents of the possible use of the same as nursing bags for babies, and

there is no evidence whatever that any of said patents were ever used for anything whatever and none of them are on the market today. Said patents are nothing but worthless paper patents without utility, which have contributed nothing *to the progress* of science and useful arts. All of the prior patents of the so-called prior art are superseded by the highly meritorious invention of the nursing bag of the appellant Syracuse's patent in suit. Every prior patent cited against the patent in suit is, to say the least, of doubtful novelty, utility or patentability. Such doubts have been removed from the appellant's patented bag, the patentability of which has been conclusively established by the extraordinary commercial success and practical utility of the appellants' patented bag, from the benefits of which invention the inventor, Frances P. Syracuse, has been deprived by the wilful, wanton and unscrupulous infringers, who should be behind the bars. The defendant in the present case sold the appellants' patented bag the first year to the amount of \$100,000. Another dishonorable infringer has become a millionaire from his ill-gotten gains by infringement of the appellants' patent. We can name many other wilful infringers, but the appellants will not bother to name them, when it will be infinitely more profitable to sue them promptly in other circuits.

The Shanzer invalid patent was still-born in the public domain when the Plaintiffs' Exhibit X had been on sale and in public use for over ten years prior to Shanzer's date of application for patent, and anyone, including the appellants, could have made, used

and/or sold the Shanzer, so-called, *patented* bag with impunity, in view of said Plaintiffs' Exhibit X. The Shanzer design patent discloses nothing but the *external appearance of the ornamental design* of the Shanzer bag, which disclosure finds its legal analogue in the equivalent Plaintiffs' Exhibit X. The invention of the novel *combination of mechanical elements of the claim* of the patent in suit is not disclosed in the Shanzer bag because said novel combination of elements of the invention of appellants' patented bag is concealed within the bag of the patent in suit of appellants' invention and are not exposed to view. Any structure which is concealed is not a subject of a *design* patent which covers nothing but the appearance of a design.

“Inasmuch as design patents are based upon the appearance or impression created, the things which are usually hidden from view are not embraced in design patents.”

Patent Law and Practice—Amdur 64, sec. 49:

“It (insulating plug—Ed.) is used overhead, out of reach and out of sight to the naked eye, so far as its design is concerned, and when in use is covered up.” (Design of plug not patentable.) *Williams v. Syracuse Co.*, 161 Fed. 571 (N.D. N.Y. 1908).

There is *no mechanical structure whatever inside of the Shanzer external design* patent and consequently the invention of the patent in suit is neither on the outside nor inside of the Shanzer ornamental patent.

We do not agree with the court's opinion "that one look at the bag is enough to convince a court that it lacks the elements that the United States patent laws were intended to protect." Such opinion might apply only to a design patent, but the *patentability of a novel mechanical functional* invention like the invention of the patent in suit cannot be determined merely by just looking at the *outside* of it. With appellant's invention absent from the *inside* or outside the Shanzer bag, to attempt to find the appellants's invention in the Shanzer bag by merely looking into the space inside of the bag, would be like looking into a dark closet for a black hat which is not there.

"A prior device, in order to anticipate, must have been *complete, and capable of producing the result sought to be accomplished*, and this must be shown by the defendant."

*Cold Metal Process Co. v. Carnegie-Illinois Steel*, 180 F. (2d) 322, C.C.A. 3 (1939) c. a. 309 U.S. 665, 84 L. Ed. 1012 (1940).

The Shanzer patent fails to show or describe the following indispensable elements of the patent in suit:

1. Two laterally spaced longitudinally extending normally closed zippers 23 and 24.
2. The two zipper openings being separated by a narrow strip 25.
3. A waterproof longitudinal panel 32 dividing the interior of the bag body 10 into two laterally spaced diaper compartments 33 and 34, one of which compart-

ments to contain clean diapers, and the other compartment to contain soiled diapers.

4. Zippers 23 and 24 operable from the outside of the bag.

5. Waterproof plastic sheeting 46 attached to inside of the bag body 10 along the edges of the end zipper-closed pockets 50 for nursing bottles 51.

All of the above elements of *the claim* of the patent in suit, except the zippers, are *concealed within* the bag 10 of the patent in suit, but none of said elements, which constitute the invention of the patent in suit, and are not found in the Shanzer or patents of the appellee's alleged so-called closest of the prior art.

“Prior patents cannot be reconstructed in the light of the invention involved in a patent infringement suit, and then used as part of the prior art.” (*Payne v. Williams-Wallace Co.*, 117 Fed. (2d) 283 C.C.A. 9 (1941), c. d. 313 U.S. 572, 85 L. Ed. 1530).

In *Electro Mfg. Co. v. Yellin* (C.C.A. 7) 56 U.S.P.Q. 290, 292; 132 F. (2d) 979, it was held:

“Of course anticipation of a mechanical patent (like appellants' patent) is not established by a design patent (like Shanzer's) which does not disclose the structure of the mechanical patent.”

Appellee's attorney in attempting to invalidate the patent in suit takes a plurality of unused and unknown paper patents of the prior “rot” and argues that by modifying them in the light of the patent in suit a syn-



thetic bag structure may be produced *nunc pro tunc* to anticipate the invention of the Syracuse patent in suit, but such practice has long ago been condemned by the Supreme Court in *Topliff v. Topliff et al*, 145 U.S. 156, 36 L. Ed. 658 and by *Kellogg Switchboard & Supply Co. v. Michigan Bell Tel. Co.*, 99 F. (2d) 207; cert. den. 308 U.S. 582, 84 L. Ed. 488 (1939).

See also *Williams Mfg. Co. v. United States Shoe Machinery Corp.*, 121 F. (2d) 273. Affirmed 316 U.S. 364, 62 S. Ct. 1179.

All of the "so-called closer prior art patents cited by appellees' attorney are designed and adapted for different purposes from that claimed by the patent in suit.

"A prior device does not anticipate even though by modification it may be made to accomplish a function performed by the patent in suit, if not designed for that purpose by its maker or adapted for use therefor." *Kellogg v. Michigan Bell, supra*.

"Nor is it proper, in determining patentable invention, 'to take this and that from the references and achieve a *nunc pro tunc* solution of the problems confronting the inventor when he made his invention.' " *Luck v. Coe*, 69 F. (2d) 379, App. D.C. (1934); *Ace v. Exhibit Supply*, 119 F. (2d) 349, mod. 315 U.S. 126, 86 L. ed. 736.

## APPELLEES' LACK OF DEFENSE

Finally, this court has overlooked the fatal weakness of the appellees' lack of defense on this appeal, and has misspent its time in trying to throw the appellants' meritorious case out of Court on a false technicality ill-conceived by appellees' attorney. His entire policy of his pseudo defense is nothing but spoilation of the record and confusion of the real merits of the case, but he is only basking temporarily in the sunshine of a fool's paradise, with no evidence, that a court of justice can recognize, to prove anything in his favor. He cannot act as a *witness* in this case and attorney for the defendant, and he has no witness to prove anything. All evidence which he has attempted to introduce in the case by way of affidavit must necessarily be stricken, and the appellees' case falls to the ground. It is idle for such an attorney to attempt with no evidence to prove the appellants' patent in suit invalid in the face of the *statutory* presumption of validity of the patent in suit (Title 35, U. S. Code, Ch. 29, Sec. 282), which presumption can only overthrow by proof beyond a reasonable doubt which proof requires a trial on the merits of the case, which appellants have been unlawfully denied and are entitled to.

## CONCLUSION

The plaintiffs-appellants have been subjected to great injustice by the Federal courts of their home circuit. Their patent in suit was not before the lower court, yet that court irregularly rendered a summary judgment on that absent patent, which was wrong, and this court has not vacated and dismissed, and righted that irregular and wrong summary judgment. Two "wrongs" do not make a "right." The appellants' counsel was thrown out of the Temple of Justice because this court only thought that he did not come into said temple through the front door, but the court was obviously mistaken, as pointed out in this petition. *The plaintiffs-appellants have not had their day in court.* Reform of the American patent system is in order.

WHEREFORE appellants demand that this court vacate and dismiss the summary judgment of the lower court and remand this case to the lower court for trial on its merits *de novo*, and *that appellants have their day in court.*

Respectfully submitted,

ALAN FRANKLIN

*Attorney for*

*Appellant-Petitioner*



**CERTIFICATE**

I hereby certify that I am counsel for the appellant and petitioner, and that in my judgment the foregoing petition for rehearing is well founded and that it is not interposed for delay.

ALAN FRANKLIN

